

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Emma HILLS et al.) Group Art Unit: 1797
Application No.: 10/562,052) Examiner: Sean E. Conley
Filed: April 28, 2006) Confirmation No.: 6173
For: TAGGED SCALE INHIBITING)
POLYMERS, COMPOSITIONS)
COMPRISED THEREOF AND)
PREVENTING OR CONTROLLING)
SCALE FORMATION THEREWITH)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement ("Action") dated January 12, 2010, Applicants submit herewith the following Response.

The Office has required that the present application be subject to a Restriction Requirement as detailed at pages 2-4 of the Action.

Applicants respectfully traverse the Restriction Requirement as set forth by the Examiner. Moreover, Applicants respectfully assert that Groups I and II should properly be examined together. Further, Applicants submit that Groups I and II are closely related and that a proper search of any of the claims should, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to all pending claims is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering all claims related to the present disclosure. The alternative is to proceed with the filing of numerous applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Regardless of whether the two groups are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. M.P.E.P. § 803 requires that if "the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions". Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the Restriction Requirement are requested.

Nevertheless, Applicants hereby elect, with traverse, Group I (*i.e.*, claims 16-29, 31, and 32).

Applicants have no intention of abandoning any non-elected subject matter and should it be necessary, Applicants expressly reserve the right to file one or more continuation and/or divisional applications directed to non-elected subject matter.

The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,
BUCHANAN INGERSOLL & ROONEY PC

Dated: February 12, 2010

By 
Shruti S. Costales
Registration No. 56,333

Customer No. 21839
P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620